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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,186	02/25/2004	Hugh S. West JR.	14000.8.1.1	2078
22913	7590	12/23/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			KIM, JOHN	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,186

Applicant(s)

WEST ET AL.

Examiner

John Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to suture separation and organization device, classified in class 606, subclass 233.
- II. Claims 22-24, drawn to a method for repairing a patient's joint, classified in class 623, subclass 13.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case repairing a patient's joint can be performed with many different devices or by hand.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John Guynn on December 19, 2005, a provisional election was made without traverse to prosecute the invention of I (device), claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claims 20 and 21 are objected to because of the following informalities: Claim 20 seems to be incomplete and claim 21 fails to have a preamble. Examiner notes that claim 13 reads similar to claims 20 and 21 (when read together). Thus examiner will disregard the "21" and add the "a graft tensioning device..." to claim 20. Claim 21 is then withdrawn as no written claim. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9, 11-13, 14, 15, 18, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 11-16 of copending Application No. 10/651671 ('671, Apparatus and methods for independently conditioning and pre-tensioning a plurality of ligament grafts during joint repair surgery, filed 8/29/03). Although the conflicting claims are not identical, they are not patentably distinct from each other because both describe using a tensioning device with a suture separator. The difference between this application claims and '671 application claims lies in the fact that '671 application claims include more elements with respect to the tension device and are thus more specific. Thus the invention of the '671 application claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the '671 application claims, they are not patentably distinct from the '671 application claims. Furthermore, specific claims from '671 application basically reads upon this application. For instance, '671 application claims 12-16 reads on this applications claims (in parenthesis): 12 (2, 3,15), 13 (4), 14 (9), 15, (5, 12, 18), and 16 (6, 7).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Notes

Examiner notes in claim 1, applicant uses "means for" language, which may be defined in the specification. However, applicant also may have defined the "means for" language dispersed in the depending claims (2-12). At this time, examiner will not invoke 35 USC 112 6th paragraph for claim 1, as seen below in this office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

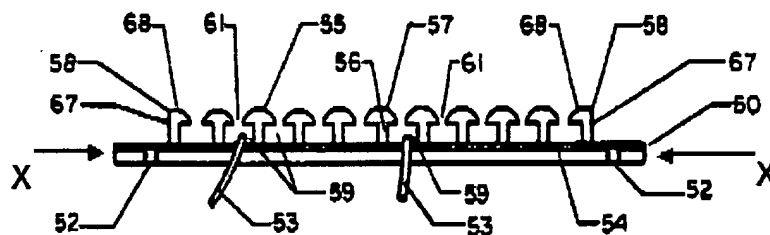
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jain (US Pat 5207703).

In regard to claim 1, 2, and 15 Jain teaches of having a suture separator that has an elongated body with a gripping head (either left or right side) and a chiseled end (52, opposite to gripping head). Please see figure 7. Regarding claim 3 and 9, Jain teaches of having a plurality of attachment passages or recesses (59) which can partially be received with a post from a tension device. Regarding claim 4 and 11, Jain teaches of having a first or second retention recesses or protrusions (59 or 55). Regarding claim 5, two of Jain's invention can be used in tandem to separate sutures. Regarding claim 6, two of Jain's invention, with the protrusions (55) facing each other,

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would form a recess for an interference screw can be inserted. Regarding claim 7 and 16 Jain's invention has at least two surfaces. Regarding claim 8, one of these surfaces (as seen in fig 7) is flat, and when one takes a cross section along the long axis of the invention (line x, please see below), the body of the invention is seen to have an elliptical or ellipsoidal cross section. Regarding claim 10 and 17 Jain shows the post guide (59) extends from one surface to the other. Regarding claim 14, Jain teaches his invention to have a body (50), passages or recesses (59), recess or protrusions (59 or 55) on the perimeter of the body, and a passageway or recess for screw (59).

**FIG. 7**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain (US Pat 5207703).

In regards to claim 12 and 18, Jain teaches of having suture retention recess or protrusions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the suture separator of Jain with only four recesses or protrusions since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In regards to claim 19, Jain teaches of having recess or protrusions except for having the recesses or protrusions on the second side. It would have been obvious to one having ordinary skill in the art at the time the invention was made to move some of the recesses or protrusions to the second side, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain (US Pat 5207703) in view of Goble et al (US Pat 5713897, in IDS).

Jain teaches of having a suture separator, but fails to disclose a graft tensioning device. Goble teaches of a ligament tensioning device that would apply a desired tensile load to one or more grafts. It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Jain in view of Goble in order to apply a tensile load to sutures, attached to a graft, with a suture separator to allow organization if there were a plurality of sutures.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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